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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,069	01/02/2004	Aleksandar Milosavljevic	GMX 071394-CON	1242

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01/26/2005

EXAMINER
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DEJONG, ERIC S

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/751,069	<b>Applicant(s)</b> MILOSAVLJEVIC ET AL.	
	<b>Examiner</b> Eric S. DeJong	<b>Art Unit</b> 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004 and 15 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 61-80 is/are pending in the application.
- 4a) Of the above claim(s) 71-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 61-80 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

The communication filed by applicant on 15 July 2004 comprising amendments to the title, drawings, specification and claims is acknowledged. The amended set of claims replaces all previous versions of the claims.

### ***Election/Restrictions***

Applicant's election without traverse of Group I, claims 61 -70 in the reply filed on 08 November 2004 is acknowledged.

Claims 71-80 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 08 November 2004.

Cancellation of claims 1-60 is acknowledged from the reply filed on 15 July 2004. Claims 61-70 are presently under examination.

### ***Provisional Double Patenting Rejections - 35 USC § 101***

Claims 61-70 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3, 4, 26-29, and 31-33 of copending Application No. 10/613434. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Art Unit: 1631

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 61-65 and 68-70 are rejected under 35 U.S.C. 102(e)(2) as being clearly anticipated by Anderson, Patent Number 6,456,942.

In regards to claim 61, Anderson teaches a method for control of and display from devices for biological and chemical processing. A preferred embodiment features a computer interface with equipment useful for biological and chemical processing and synthesis in a remote manner (a method of requesting genomic services from a service provider and providing genomics services to a client; a process for remotely conducting a genomics experiment; under control of a service provider; under control of a client). See Anderson, column 1 lines 9-12 and 36-46 and column 6, lines 5-9. Further, Anderson teaches that the invention applies to the fields of chemical and biological synthesis such as the preparation of peptides, oligomers, polymers, nucleic acids (providing one or more biological samples; identifying one or more genome sequences; obtaining said samples and said genomic sequences; modifying said set of genomic sequences subsequent to said informing step). See Anderson, column 2, lines 26-39. Further, Anderson teaches a preferred embodiment of the invention that features a computer remotely in interface with a solid phase array or "gene chip" for synthesized DNA sequences (providing one or more microarrays wherein each of said microarrays contains at least one of said genome sequences; applying at least one of said biological samples to at least one of said microarrays). See Anderson, column 5, lines 7-31.

In regards to claims 62-65, 68, and 69, Anderson teaches a particular application where a user may determine whether a set of target nucleic acid sequences that are in a solution and that the target sequences may be transmitted from the user remotely via a network, such as the Internet, to a server (providing a repository of biological samples; providing a catalog of said repository; accessing said catalog; identifying a set of

Art Unit: 1631

genomic sequences; selecting said biological samples from said catalog; said steps of providing a catalog and accessing said catalog occur over an internet connection; a process for remotely selecting samples from a biological repository; providing a database of said samples in said biological repository; determining if said genomic sequences are present in said samples; providing a network connection to said database accessible by a client; accessing said database over said network; selecting a subset of said samples from said biological repository; said network is the internet; receiving data representative of said applying step over the internet; informing said client of results of said determining step). See Anderson, column 6, lines 30-53.

In regards to claim 70, Anderson teaches that each sequence is to be placed at unique grid positions on a DNA chip array (identifying said samples with unique identifiers). See Anderson, Figure 4 and column 3, lines 11-33.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

Art Unit: 1631

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 61-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson taken in view of Aryev et al.

Anderson teaches the above described invention for a process of remotely selecting samples from a biological repository. However, Anderson does not teach the use of a database that includes clinical records or phenotype information corresponding to at least a portion of said samples. Aryev et al. teaches an integrated clinical laboratory software system for testing a specimen and an automated hardware platform. See Aryev et al., Abstract and column 1 lines 7-11. Further, Aryev et al. teaches that hospitals and clinical laboratories are under increasing pressure to provide more and better results with less time and funding resources. As such, various automated systems are relied upon to meet the increase in pressure and performance demands. See Aryev et al., column 1 lines 24-57.

In regards to claims 66 and 67, Aryev et al. teaches an embodiment of the invention wherein the work flow automation programming can maintain a database of test results data received from a specimen and verify medical insurance data (said database includes clinical records corresponding to at least a portion of said samples; said database includes phenotype information corresponding to at least a portion of said samples). See Aryev et al., column 3, lines 51-63.

Art Unit: 1631

Taken in view of Arvey et al., it would be obvious to one of skill in the art to include clinical records and phenotype information in a database corresponding to at least a portion of samples used in a process of remotely selecting samples from a biological repository as described by Anderson.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric S. DeJong whose telephone number is (571) 272-6099. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D. can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*Ardin H. Marschel* 1/24/05  
ARDIN H. MARSCHEL  
PATENT EXAMINER